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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/759,684	01/10/2001	Larry L. Hood	155694-0067	3084
7590 05/06/2005			EXAMINER	
Ben J. Yorks Irell & Manella, LLP Suite 400 840 Newport Center Drive Newport Beach, CA 92660			SHAY, DAVID M	
			ART UNIT	PAPER NUMBER
			3739	
DATE MAILED: 05/06/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/759,684

Applicant(s)

HOOD ET AL.

Examiner

david shay

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on December 15, 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 11,13,14,16,18,20,21 and 23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11,13,14,16,18,20,21 and 23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

Applicant argues that Doss et al does not limit the penetration of the tip because it prevents the penetration thereof. The examiner must respectfully disagree. The device of Doss et al limits the penetration depth to zero. While the tip of Doss et al does not extend from the stop, the tip of Schachar clearly does. Both the disclosures of Schachar and Doss et al seek to control the relative positions of the probe and the cornea. While Doss et al configure their device so that the tip does not touch the cornea, there is no admonition in Doss et al that this must not happen. While regression is noted by Feldman et al, it is not clear that this is the precise technique used by Schachar.

Claims 11, 13, 14, 16, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Doss et al in combination with Schachar and Wuchinich. Doss et al teach a device which can deliver energy at 100 KHz-10MHz (see col. 3, lines 46-51), with a ground pad (see Fig. 1, element 36 and col. 3, lines 41-44), a connector arrangement as claimed (see elements 12, 16, and 20 or 12, 26 and 28 in figure 5) and a stop (see element 42 in figure 5). Doss et al also teach the application of power in bursts of "about one second" (see col. 3, line 50) as well as the typical corneal thickness and desired temperature ranges to heat the tissue (see col. 1, line 38-68). Schachar teaches a system for heating the corneal stroma including probe tip which is heated to heat the stroma wherein the last 300 to 600 microns is considered to be the tip and the shaft of the probe is considered a "spring beam" since its function is to help maintain contact with the tissue to be heated. Wuchinich teaches the use of a pulsed periodic damped waveform for coagulation. It would have been obvious to the artisan of ordinary skill to employ the power source and connection of Doss et al to maintain the power level at or below 1.2 watts, since the desired temperature changes to produce the effect are known, and thus the appropriate wattage

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would also be known. Doss et al also teach the desired temperature for shrinkage of tissue and the use of RF in the claimed frequency and time exposure range to provide the shrinkage; to either employ the connections of Doss et al in the system of Schachar, since Schachar teaches no particular power source or to employ the probe configuration of Schachar in the device of Doss et al, since this would provide a more localized application of heat to the stromal tissue and to maintain the power level at or below 1.2 watts, since the desired temperature to produce the effects are known and thus the appropriate wattage would also be known, further the exact power level and duration being dependant on the probe geometry of Schachar being the same as that of applicants probe, the power requirement would be the same, and to employ a damped waveform, since this is the waveform used for coagulation and to employ a pulse repetition rate; the precise repetition rate determining the temperature that the tissue will reach; and the temperature for corneal shrinkage is known, as taught by Doss et al, thus producing a device as claimed.

Claims 20, 21, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Doss et al in combination with Schachar and Wuchinich. The teachings of Wuchinich and Doss et al and the motivations for combinations and modification thereof are essentially those already set forth above. Thus it would have been obvious to the artisan of ordinary skill to combine these old and well known teachings to produce a method such as claimed.

Applicant's arguments filed December 15, 2004 have been fully considered but they are not persuasive. These arguments are not convincing for the reasons set forth above.

Any inquiry concerning this communication should be directed to David M. Shay at telephone number 571-272-4773.

